

REMARKS/ARGUMENTS

With this amendment, claim 147 is cancelled. Claims 1-142 and 154-187 were previously cancelled. With this amendment, claims 143, 148, 149, 150, 151, 152, and 153 are amended. Support for amended claim 143 can be found on page 79 line 3, page 73, lines 6 and 10, page 35, lines 19-21, and page 36, line 16 to page 37, line 10.

Claims 143-153 were rejected under the judicially created doctrine of obviousness type patenting over US Patents 6,150,176 and 6,780,975. Based on the amendments to claim 143, Applicants believe that the rejection is now moot. However, to the extent that the Examiner may believe that the rejection still applies to the amended claim, Applicants respectfully traverse.

The fact that a claimed species is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. *In re Baird*, 29 USPQ 1550 (Fed. Cir. 1994). For the disclosure of a genus to render a species obvious, the prior art must provide some motivation to select the claimed genus. *See, e.g., In re Deuel*, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 26 USPQ2d 1529 (Fed. Cir. 1993).

As amended, the claims now recite variants of YFP (yellow fluorescent protein). YFP itself is a variant of GFP (SEQ ID NO:2) in which the following residues are mutated: T203Y; S65G; S72A; and V68L. Furthermore, the claim also requires that the protein have the following substitution: H148Q or H148G. Finally, the claim requires that the protein have at least one or more additional mutation selected from the group consisting of: Y66H, F, or W; Q69N or K; R96K; Q183N or K; and the substitutions listed in Table F. Although US Patents 6,150,176 and 6,780,975 generically describe protein variants of GFP (SEQ ID NO:2) that include mutations at T203 and H148, none of the claims recite the particular species that is now recited in the amended claims. The claims now recite a selection invention, corresponding to a particular species, that is not rendered obvious by the genus claims of the cited patents. Although the claims of the cited patents encompass the instant species, the genus described by the cited patents is so large that it does not render obvious the particular species of the instant claim. One of skill in the art would not have been motivated to select the claimed species from

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the vast universe of species encompassed by the cited patents. Applicants therefore request that the rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,


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